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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,619	04/02/2004	Kia Silverbrook	HYG014US	2058
24011	7590	08/10/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			KIM, TAE W	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/815,619	Applicant(s) SILVERBROOK ET AL.	
	Examiner Tae W. Kim	Art Unit 2876	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 15-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/01/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim(s) 1-11, 15-17, 19, 25, 27, 28, 30-35, 37, and 43 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Gogulski (US 4071740) in view of Berstis (US 7010498).

Re claim 1: Gogulski discloses a shopping receptacle (fig 1 part 22), having a shopping receptacle identity (col 7 lines 56-58), for receiving and retaining a product item having an interface surface associated therewith, the interface surface having disposed thereon or therein first coded data including a plurality of coded data portions, each coded data portion being indicative of an identity of the product item (col 5 lines 27-35), wherein the receptacle comprises:

- (a) a receptacle body adapted to receive and retain the product item and having an opening through which the product item may be placed within the receptacle body (fig 1 part 22);
- (b) a sensing device adapted to:  
sense at least some of the first coded data on the interface surface of the product item as the product item is placed within the receptacle body (fig 1 parts 26 & 46), and generate

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indicating data indicative of the identity of the product item (col 5 lines 27-35 & 51-54, col 6 lines 2-16); and,

(c) a weighing device for sensing the weight of the product item (figs 1 & 2 part 24), and generating weight data indicative of the sensed weight, the weight data; and

(d) means for transferring the indicating data, the weight data and receptacle identity data to a computer system (fig 3 part 66) which (col 5 lines 51-59, col 6 lines 24-33):

(i) determines, using the indicating data, an indicated weight of the product item in accordance with weight indications stored in a data store (col 6 lines 14-16 & 24-33);

(ii) compares the indicated weight to the sensed weight (col 6 lines 24-33); and,

(iii) is responsive to the comparison (col 6 lines 33-55).

However, Gogulski does not disclose or fairly suggest:

a sensing device adapted to:

sense second coded data on a user identity card, said second coded data being indicative of a user identity and generate user identity data; and

means for transferring the user identity data to a computer system.

Berstis however discloses

a sensing device adapted to:

sense second coded data on a user identity card, said second coded data being indicative of a user identity and generate user identity data (col 6 lines 5-10); and

means for transferring the user identity data to a computer system (fig 1b).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Berstis' sensing device to Gogulski's shopping receptacle for the purpose of providing individualized service such as discounting prices or

promoting items based on the individual shopper's purchase history. Berstis' sensing device can read both the product identifying information and the customer identifying information. \

Re claims 2 and 28: Gogulski as modified by Berstis discloses the receptacle of claim 1 and the method of claim 27, wherein the computer system generates and the action includes an alert in response to an unequal comparison (col 6 lines 33-55).

Re claim 3: Gogulski as modified by Berstis discloses the receptacle of claim 1, wherein the receptacle includes a user interface and wherein an indication of the results of the comparison is provided via the user interface (fig 1 parts 12 & 54, col 6 lines 33-55).

Re claims 4 and 31: Gogulski as modified by Berstis discloses the receptacle of claim 1 and the method of claim 27, wherein the receptacle includes the computer system (fig 1 part 12, col 6 lines 28-33).

Re claims 5 and 32: Gogulski as modified by Berstis discloses the receptacle of claim 1 and the method of claim 27, wherein the receptacle includes a communications means for communicating with the computer system (col 5 lines 55-59, col 7 lines 23-29).

Re claims 6 and 33: Gogulski as modified by Berstis discloses the receptacle of claim 1 and the method of claim 27, wherein the computer system and wherein the method includes, in the computer system:

(a) determines, using the indicating data, type data indicative of a type of the product item (col 6 lines 14-16); and,

(b) determines, using the type data, the indicated weight of the product item (col 6 lines 28-33).

Re claim 7: Gogulski as modified by Berstis discloses the receptacle of claim 1, wherein the sensing device comprises:

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(a) a laser for emitting the at least one sensing beam, the sensing beam being directed in first and second orthogonal directions to thereby generate a raster scan pattern over a sensing patch, the sensing patch being provided in the sensing region such that it exposes at least one coded data portion (col 6 lines 4-11);

(b) a sensor for sensing the at least one exposed coded data portion (col 6 lines 12-14);  
and

(c) a processor for determining, using at least some of the sensed coded data, indicating data indicative of the identity of the product item (col 6 lines 14-16).

Re claim 8: Gogulski as modified by Berstis discloses the receptacle of claim 1, wherein the computer system is adapted to:

(a) determine, using the indicating data, product information (col 6 lines 14-16 & 28-33);  
and,

(b) transfer the product information to a user interface, the user interface being responsive to the product information to display the product information (col 5 line 50 – col 6 line 1, col 6 lines 20-24).

Re claim 9: Gogulski as modified by Berstis discloses the receptacle of claim 8, wherein the computer system is adapted to, using the indicating data, add an indication of the product item to a product item list (fig 1 parts 30 & 50, col 5 lines 35-38, col 6 lines 20-24, col 10 lines 5-11).

Re claim 10: Gogulski as modified by Berstis discloses the receptacle of claim 8, wherein the computer system is adapted to, using the indicating data, provide the product item list to the user via the user interface (fig 1 parts 30 & 50, col 5 lines 35-38, col 6 lines 20-24, col 10 lines 5-11).

Re claim 11: Gogulski as modified by Berstis discloses the receptacle of claim 1, wherein the computer is adapted to:

(a) associate the sensing device with a user using the user identity and the shopping receptacle identity data (col 2 lines 52-58: Reference indicated that the association of the sensing device and user is established.); and,

(b) dissociate the sensing device and a user using the user identity and the shopping receptacle identity data (col 3 lines 20-30).

Re claim 15: Gogulski as modified by Berstis discloses the receptacle of claim 1, wherein the receptacle is at least one of:

(a) a shopping trolley;

(b) a shopping cart (fig 1); and,

(c) a shopping basket.

Re claims 16 and 35: Gogulski as modified by Berstis discloses the receptacle of claim 1 and the method of claim 27, wherein the receptacle is adapted to perform and the action includes at least one of:

(a) provide product information about the product item to the user (col 5 line 50 – col 6 line 1, col 6 lines 20-24, col 6 lines 28-33);

(b) record a purchase transaction indicating that the user has purchased the product item;

(c) record a potential purchase transaction indicating that the user wishes to purchase the product item;

(d) provide comparison information to the user, the comparison information comparing product information about the product item with product information about another product item;

(e) play a game associated with the product item; and

(f) conduct a competition in relation to the product item.

Re claims 17 and 34: Gogulski as modified by Berstis discloses the receptacle of claim 1 and the method of claim 27, wherein the receptacle is adapted to display and the action includes displaying information relating to any one of the products:

- (a) cost (col 5 line 50 – col 6 line 1, col 6 lines 20-24);
- (b) contents;
- (c) weight (col 5 line 50 – col 6 line 1, col 6 lines 28-33);
- (d) place of origin;
- (e) manufacturer;
- (f) date of manufacture;
- (g) date of packaging;
- (h) use-by date;
- (i) current owner; and
- (j) dimensions.

Re claims 19 and 37: Gogulski as modified by Berstis discloses the receptacle of claim 1 and the method of claim 27, wherein the coded data distinguishes the product item from every other product item (col 6 lines 14-16).

Re claims 25 and 43: Gogulski as modified by Berstis discloses the receptacle of claim 1 and the method of claim 27, wherein the interface surface is at least a portion of at least one of:

- (a) product item packaging (col 6 lines 10-11);
- (b) product item labeling (col 5 lines 27-30);
- (c) product manuals;
- (d) product instructions; and,



(e) a surface of the product item.

Re claim 27: Gogulski discloses a method of facilitating interaction between a user and a computer system using a shopping receptacle, having shopping receptacle identity (col 7 lines 56-58), adapted to receive and retain a product item (fig 1 part 22), the product item having an interface surface associated therewith, the interface surface having disposed thereon or therein first coded data including a plurality of coded data portions, each coded data portion being indicative of the identity of the product item (col 5 lines 27-35), wherein the method includes:

(b) transferring shopping receptacle identity data to a computer system, which initiated a shopping session:

(c) receiving a product item in a receptacle body, the receptacle body having an opening through which the product item may be placed within the receptacle body (fig 1 part 22);

(d) in the sensing device (fig 1 parts 26 & 46):

(i) sensing at least some of the coded data on the interface surface of the product item as the product item is placed within the receptacle body (col 5 lines 27-35, col 6 lines 2-16); and,

(ii) determining indicating data indicative of the identity of the product item (col 6 lines 14-16); and,

(e) in a weighing device (figs 1 & 2 part 24):

(i) sensing the weight of the product item (col 6 lines 24-33); and,

(ii) generating weight data indicative of the sensed weight,

(f) transferring the weight data and the product item identity being provided to a computer system (col 6 lines 14-16 & 24-33) which:

- (1) determines, using the indicating data, an indicated weight of the product item in accordance with weight indications stored in a data store (col 6 lines 24-33);
- (2) compares the indicated weight to the sensed weight (col 6 lines 24-33); and,
- (3) is responsive to the comparison to perform an action (col 6 lines 33-55).

However, Gogulski does not disclose or fairly suggest steps comprising

(a) in a sensing device:

- (i) sensing second coded data on a user identity card, said second coded data being indicative of a user identity, and
- (ii) generating user identity data:

(b) transferring the user identity data and shopping receptacle identity data to a computer system, which initiates a shopping session;

Berstis however discloses steps comprising

(a) in a sensing device:

- (i) sensing second coded data on a user identity card, said second coded data being indicative of a user identity (col 6 lines 5-10); and
- (ii) generating user identity data (col 6 lines 5-10);:

(b) transferring the user identity data to a computer system, which initiates a shopping session (fig 4 step 403, col 6 lines 5-10 col 1 lines 6-16);

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Berstis' steps comprising sensing device and transferring the user identity data to Gogulski's method for the purpose of providing individualized service such as discounting prices or promoting items based on the individual shopper's purchase history.

Re claim 30: Gogulski as modified by Berstis discloses the method of claim 27, wherein the receptacle includes a user interface, and wherein the action includes providing an indication of the results of the comparison via the user interface (col 6 lines 33-55).

3. Claim(s) 18 and 36 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Gogulski (US 4071740) as modified by Berstis (US 7010498) in view of Reade (US 20040103034).

Re claims 18 and 36: Gogulski as modified by Berstis discloses the receptacle of claim 1 and the method of claim 27.

However, Gogulski does not disclose or fairly suggests that the first coded data is indicative of an EPC associated with the product item.

Reade however discloses the first coded data indicative of an EPC associated with the product item (par. 0013, 0039).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Reade's teaching that the first coded data is indicative of an EPC associated with the product item to the receptacle and method of Gogulski as modified by Berstis for the purpose of being able to track the product.

4. Claim(s) 20, 21, 38 and 39 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Gogulski (US 4071740) in view of Manasse (US 20040117718).

Re claims 20, 21, 38 and 39: Gogulski discloses the receptacle of claim 1 and the method of claim 27.

However, Gogulski does not disclose or fairly suggests that the first coded data is redundantly encoded using Reed-Solomon encoding.

Manasse however discloses that the first coded data is redundantly encoded using Reed-Solomon encoding (abs., par. 0009, 0002, 0004, 0007-0015, 0019-0022, 0025, 0031, 0063, 0065, 0074).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Manasse's teaching that the first coded data is redundantly encoded using Reed-Solomon encoding to the receptacle and method of Gogulski as modified by Berstis for the advantage of using Reed-Solomon codes that the probability of an error remaining in the decoded data is usually lower than the probability of an error if Reed-Solomon is not used.

5. Claim(s) 22-24, 26, 40-42, and 44 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Gogulski (US 4071740) in view of Dougherty (US 6076734).

Re claims 22, 23, 40 and 41: Gogulski as modified by Berstis discloses the receptacle of claim 1 and the method of claim 27.

However, Gogulski as modified by Berstis does not disclose or fairly suggests that the first coded data is substantially invisible to the unaided eye and wherein the first coded data is printed using infrared ink.

Dougherty however discloses that the first coded data is substantially invisible to the unaided eye (col 5 lines 32-40, col 9 lines 33-36) and wherein the first coded data is printed using infrared ink (col 2 lines 59-64, col 4 lines 18-23, col 5 lines 32-58, col 10 lines 39-45).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Dougherty's teaching that the first coded data is substantially invisible to the unaided eye and wherein the first coded data is printed using infrared ink to the receptacle and method of Gogulski as modified by Berstis for the purpose of ensuring that the coded data is protected from unauthorized reading.

Re claims 24 and 42: Gogulski discloses the receptacle of claim 1 and the method of claim 27, wherein the first coded data is provided on the interface surface representing at least one of:

- (a) product information; and,
- (b) the identity of the product item (col 1 lines 22-57, col 5 line 3 – col 6 line 55).

However, Gogulski does not disclose or fairly suggests the visible markings coincident with the first coded data provided on the interface surface.

Dougherty however discloses the visible markings coincident with the first coded data provided on the interface surface (fig 1 parts 32 & 34, col 2 lines 43-58, col 5 lines 48-62).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Dougherty's visible markings coincident with first coded data provided on the interface surface to receptacle and method of Gogulski as modified by Berstis for the purpose of providing visual information about the encoded data.

Re claims 26 and 44: Gogulski as modified by Berstis discloses the receptacle of claim 1 and the method of claim 27.

However, Gogulski as modified by Berstis does not disclose or fairly suggests that the first coded data is disposed over at least one of:

- (a) substantially all of any one of:

- (i) an entire product surface;
  - (ii) packaging; and,
  - (iii) a product label;
- (b) more than 25% of any one of:
  - (i) an entire product surface;
  - (ii) packaging; and,
  - (iii) a product label;
- (c) more than 50% of any one of:
  - (i) an entire product surface;
  - (ii) packaging; and,
  - (iii) a product label;
- (d) more than 75% of any one of:
  - (i) an entire product surface;
  - (ii) packaging; and,
  - (iii) a product label.

Dougherty however discloses that the first coded data (fig 10 parts 358, 360, & 362) is disposed over at least one of:

- (a) substantially all of any one of:
  - (i) an entire product surface (fig 10 part 352, col 11 25-43);
  - (ii) packaging; and,
  - (iii) a product label;
- (b) more than 25% of any one of:
  - (i) an entire product surface;

- (ii) packaging; and,
- (iii) a product label;
- (c) more than 50% of any one of:
  - (i) an entire product surface;
  - (ii) packaging; and,
  - (iii) a product label;
- (d) more than 75% of any one of:
  - (i) an entire product surface;
  - (ii) packaging; and,
  - (iii) a product label.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Dougherty's teaching that the first coded data is disposed over substantially an entire product surface to the receptacle and method of Gogulski as modified by Berstis for the purpose of increasing the volume of information content of the coded data.

6. Claim(s) 29 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Gogulski (US 4071740) as modified by Berstis (US 7010498) in view of Schlieffers (US 20040111320).

Re claim 29: Gogulski as modified by Berstis discloses the method of claim 28.

However, Gogulski as modified by Berstis does not disclose or fairly suggests that the method includes providing the alert at a location remote to the receptacle.

Schlieffers however discloses that the method includes providing the alert at a location remote to the receptacle (par. 0066).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Schlieffers' teaching that the method includes providing the alert at a location remote to the receptacle to the method of Gogulski as modified by Berstis for the purpose of informing the control persons remotely located.

### ***Response to Arguments***

7. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Gogulski reference in combination with Berstis reference teaches a shopping receptacle having all of the features specified in claim 1 and a method having all of the steps specified in claim 27.

Furthermore, the sensing device in Berstis reference is adapted to sense first coded data on product items and sense second coded data on a user identity card. Therefore, Berstis reference suggest using its scanner to perform the dual function of scanning product items and scanning user identity cards to generate user identity data.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after



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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae W. Kim whose telephone number is 571-272-5971. The examiner can normally be reached on Mon-Fri 7AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tae W. Kim  
Art Unit 2876  
Patent Examiner

TWK

AHSHIK KIM  
PRIMARY EXAMINER

